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| EXAMINER |
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HAYES, BRET C

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| ART UNIT | PAPER NUMBER |
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3644

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,438

Applicant(s)

FORT, W. GRADY

Examiner

Bret C Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31-36, 38 and 39 is/are allowed.
- 6) ☒ Claim(s) 1-30 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 19 and 21 – 30 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling (claim 19 and 21) for receiving water from the coupling portion, does not reasonably provide enablement for not receiving water from any other basin. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to implement the invention commensurate in scope with these claims. As seen from Fig. 10, in the operating position, at elevation **D10**, there is nothing preventing the water from one basin access to another basin. Therefore, the limitation “but not from the other basin” should be stricken.

3. Any unspecified claim is rejected as being dependent upon a rejected base claim.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10, 17 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 10 recites the limitations "the rectangular sleeve" in lines 2, 3 and 5 (3X), and "the four legs" in lines 4 and 5. There is insufficient antecedent basis for these limitations in the claim.

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7. Re – claims 17 and 37, both recite "a sleeve" in lines 1 and 2, respectively. Since the base claim already recites a sleeve, it is unclear whether this is a separate and distinct sleeve or the sleeve as previously recited. Examiner presumes the latter and recommends replacing "a" before "sleeve" with --the--, for clarity, in both claims.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 – 3, 11 – 14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,195,463 to Lorenzana.

10. Re – claims 1 and 11, Lorenzana discloses the claimed invention including a bird bath 10 comprising a coupling portion 20 to be coupled to a water reservoir 68 and a basin portion 12 configured to have fluid communication with the coupling portion 20, wherein the basin portion 12 is sized to accommodate at least one bird, and a support portion 28 located beneath one or both of the coupling portion 20 and the basin portion 12, wherein the support portion 28 comprises a sleeve configured to receive a mounting post, as set forth at col. 3, line 13 – 15, for example, wherein a first end of the sleeve is connected to a bottom surface of the coupling portion 20, as at 24, and a second end of the sleeve is configured to touch a surface on which the support portion 28 rests. If support portion rests on a post, then the second end of the sleeve would inherently touch its surface. Further, although Lorenzana discloses ¾" I.P.S. pipe, as at col. 3, line 15, for example, it is well known in the bird bath mounting art that mounting 'posts'

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can include cylindrical, metal tubes or pipes. The term “post” does not serve to patentably distinguish as a claimed structural limitation.

11. Re – claims 2 and 12, Lorenzana discloses further comprising a channel **22** having an inlet, nearest portion **20**, and an outlet furthest from portion **20**, so configured.

12. Re – claim 3, Lorenzana discloses wherein the basin portion **12** comprises a rim **16** having a cantilever, as at **38**.

13. Re – claim 13, Lorenzana discloses the support portion **28** being so configured. It would appear from the drawings, specifically, Figs. 7 and 8a, for example, that the support portion **28** is capable of the claimed configuration. That is, portion **28** is capable of resting on a flat surface.

14. Re – claim 14, Lorenzana discloses wherein the basin portion **12** comprises a leg **40** connecting a bottom surface of the basin portion **12** to the support portion **28**, see Fig. 8a, for example.

15. Re – claim 17, Lorenzana discloses wherein the sleeve has a length, wherein the length is about or greater than a radius or one-half of a thickness of the mounting post, see above. It is apparent from the at least Fig. 8a, for example, that the length of the sleeve is about or greater than the radius or one-half of a thickness of the mounting post. See above.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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17. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorenzana as applied above.

18. Re – claim 6, Lorenzana discloses the invention including a pair of legs 40 except for four legs. It would have been obvious to one having ordinary skill in the art at the time the invention was made to increase the legs from two to four, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In this case, one would be motivated to do so for structural support reasons.

19. Re – claim 8, Lorenzana discloses the invention as applied to claim 6 above.

20. Claims 4, 5, 18 – 23, 25 and 28 – 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorenzana as applied above in view of Forjohn (previously cited).

21. Re – claims 4, 5 and 18, Lorenzana discloses the claimed invention except for any plurality of basins. Forjohn teaches the utilizing a plurality, see Figs. 1, 2 and 4 – 7, for examples, in the same field of endeavor for the purpose of accommodating differing sizes and species of birds. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Lorenzana to make the basin a plurality as taught by Forjohn in order to accommodate various bird sizes and species.

22. Re – claim 19, Lorenzana in view of Forjohn, as applied to claim 18 above, discloses the invention as claimed. Lorenzana discloses a basin being so configured.

23. Re – claim 20, Lorenzana in view of Forjohn, as applied above discloses the claimed invention. Forjohn further teaches first and second basins being located on opposite sides of a coupling portion in the same field of endeavor for the purpose set forth above. It would have

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been obvious to one having ordinary skill in the art at the time the invention was made to further modify Lorenzana to include first and second basins being located on opposite sides of a coupling portion as taught by Forjohn for the reasons set forth above.

24. Re – claim 21, Lorenzana in view of Forjohn discloses the invention as claimed as applied to claims 1 and 4 above, for example.

25. Re – claims 22 and 23, Lorenzana discloses the claimed invention including spiral threads, see Fig. 8a, for example, as mating units for coupling the reservoir 68 with the base 12.

26. Re – claim 25, Lorenzana discloses a hanging device 50 being disposed on the reservoir 68, as seen in Figs. 1, 3 and 4, for example.

27. Re – claims 28 – 30, Lorenzana in view of Forjohn discloses the claimed invention as applied above.

28. Claims 7, 9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorenzana as applied above in view of US Patent No. 6,354,244 B1 to Green.

29. Re – claims 7 and 16, Lorenzana discloses the invention substantially as claimed as applied above, except for the sleeve being a rectangular sleeve. Green teaches an octangular sleeve, wall portions 726, in the same field of endeavor for the purpose of securely supporting a bird feeder, see Figs. 32O and 32P, for example. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lorenzana to include a octangular sleeve as taught by Green in order to support the apparatus on an octangular mounting post. In light of the teaching of Green, it would have further been obvious to one having ordinary skill in the art at the time the invention was made to modify Green to include a rectangular sleeve, since mounting posts are well known in the art to be square, and since there is no invention in merely

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changing the shape or form of an article without changing its function except in a design patent.

Eskimo Pie Corp. v. Levous et al., 3 USPQ 23. In this case, given that Green teaches making a special sleeve with eight walls to mount to a special mounting post, to diminish this to four as would be required for a normal, square mounting post would be within the level of ordinary skill in the art at the time the invention was made.

30. Re – claim 9, Lorenzana in view of discloses the invention as applied to claims 6 and 7 above.

31. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorenzana as applied above in view of Forjohn in view of Green.

32. Re – claims 26 and 27, Lorenzana in view of Forjohn discloses the claimed invention as applied above to include claims 1 and 4, for example. Green teaches a polygonally-shaped sleeve as applied to claim 7 above.

33. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lorenzana in view of US Patent No. 6,484,666 to Reusche.

34. Lorenzana discloses the invention substantially as claimed except for further comprising a removable plug disposed on the basin portion 12. Reusche teaches removable plugs, for couplers 106 and 112, for example, in the same field of endeavor for the purpose of filling the bird bath manually, as with a hose. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lorenzana to include the removable plugs as taught by Reusche in order to fill the bird bath as with a hose.

35. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lorenzana in view of Forjohn in view of Reusche.

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36. Re – claim 24, Lorenzana in view of Forjohn discloses claimed invention as applied above. Reusche teaches removable plugs as applied above.

Allowable Subject Matter

37. Claims 31 – 36, 38 and 39 are allowed.

38. Claim 37 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

39. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record discloses the claimed invention as applied above. However, the prior art of record does not disclose nor reasonably teach the combination of elements including a coupling portion configured to couple with the reservoir in an operating position and a refilling position, wherein water is shutoff from the basin portion when the reservoir is set in the refilling position.

40. This statement is not intended to necessarily state all the reasons for allowance or all the details why the claims are allowed and has not been written to specifically or impliedly state that all the reasons for allowance are set forth (MPEP 1302.14).

Conclusion

41. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (571) 272 – 6902. The examiner can normally be reached Monday through Friday from 5:30 am to 3:00 pm, Eastern Standard Time.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu, can be reached at (571)272 – 7045. The fax number is (703) 872 – 9306.

bh

5/21/05



MICHAEL J. CAYONE
SUPERVISORY PATENT EXAMINER